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In the

Supreme Court of the United States.

OCTOBER TERM, 1945.

No. 297

RUSSELL BOX COMPANY,
Petitioner,

v.

GRANT PAPER BOX COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI
AND
BRIEF IN SUPPORT OF MOTION.

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OCTOBER TERM, 1945.

No.

RUSSELL BOX COMPANY,
PETITIONER,
v.
GRANT PAPER BOX COMPANY,
RESPONDENT.

PETITION FOR WRIT OF CERTIORARI.

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, Russell Box Company, defendant, respectfully prays for a writ of certiorari to the Circuit Court of Appeals for the First Circuit to review a judgment of that Court entered on April 17, 1946.

SUMMARY AND SHORT STATEMENT OF THE MATTER INVOLVED.

This action was brought by respondent in the District Court of Massachusetts to enjoin infringement of claim 3* of Letters Patent to Dreymann No. 2,031,036, dated Febru-

* 3. "A container wall for the packaging of material including a sheet or film composed substantially of an amorphous petroleum wax of an apparent melting-point of 120°–170° F., carrying a suspended colloid, and two sheets of fibrous material, the sheet or film of said wax intercalated between the sheets of fibrous material and constituting a film of adhesive uniting the whole."

ary 18, 1936. The District Court held claim 3 not infringed but did not pass on its validity (R. 14). On appeal the Circuit Court of Appeals for the First Circuit (R. 465) found the patent invalid, affirming the decree of the District Court, but on rehearing reversed itself and held the claim valid and infringed (R. 487).

The alleged invention consisted in substituting amorphous petroleum wax containing a suspended colloid for paraffin wax as the adhesive to stick together two sheets of paperboard to make paper boxes used to contain food and the like and protect them from moisture.

It was old to stick two plies of paper or paperboard together with a flexible layer of any of various waxes,[1] and to make boxes from such laminated sheets.[2] Paraffin wax and "other mineral, animal or vegetable waxes" and "oxidized petroleum residuum"[4] had been used for the purpose. Colloids such as rubber,[5] resin,[6] and ester gum[7] had been mixed with waxes to improve their properties. Also it was old to waterproof various articles with a colloidal suspension of ester gum in "petrolatum wax", another name for amorphous petroleum wax.[8]

Dreymann substituted amorphous petroleum wax containing a foreign (added) colloid for the paraffin wax and rubber (a colloid) used by Johnson,[9] or for the "oxidized petro-

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[1] Johnson, No. 229,045 (R. 438), Beecher, No. 1,936,375 (R. 448). Fietsch, No. 1,269,918 (R. 456).

[2] Fietsch, No. 1,269,918 (R. 456).

[3] Beecher, No. 1,936,375 (R. 448).

[4] Fietsch, No. 1,269,918 (R. 456).

[5] Johnson, No. 229,045 (R. 438).

[6] MacLaren, No. 1,905,923 (R. 445).

[7] Earsall, No. 1,968,907 (R. 451); Rose, No. 2,036,301 (R. 453), filed April 12, 1933, see the claims and p. 1, col. 2, lines 1–3.

[8] Hoch, No. 1,780,917 (R. 442).

[9] Johnson, No. 1,936,375 (R. 438).

leum residue" used by Fietsch.[10] He followed Beecher's suggestion to use "other mineral, animal or vegetable waxes".[11] Dreymann's wax compound performed no new function, produced no different co-operation and was coupled with no new process. The only advantages gained were in the degree of flexibility and moisture-proofness, and were due entirely to the nature of the substituted material.

Amorphous petroleum wax came on the market in about 1929 (R. 85). It is moisture and waterproof, non-brittle, intensely sticky, tacky, gummy and adhesive (R. 471). These properties were well known. Such waxes contain natural colloids (R. 395–401). Dreymann, the patentee, did not know this and added a foreign colloid to wax which did not contain it originally.

Petitioner (defendant) bought in the open market amorphous petroleum wax containing an inherent resinous colloid, and used this wax to laminate paperboard for paper boxes (R. 471).

The Court of Appeals held claim 3 valid and infringed, and thus decided that it amounted to invention to substitute one known wax for another in making moisture-proof boxes. Disregarding a file-wrapper estoppel, it expanded the claim to cover commercial waxes containing natural colloids.

Therefore, the decision of the Court of Appeals upholds a monopoly in the use of a known material existing in nature when substituted for a similar material in an old combination; it upholds invention where the only novelty lies in the substitution of one material for another without difference of function or method.

The Court of Appeals came to its erroneous decision

(1) Because it failed to follow the applicable rule of *Hotchkiss* v. *Greenwood,* 11 How. 248, and

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[10] Fietsch, No. 1,269,918 (R. 456).

[11] Beecher, No. 1,936,375 (R. 448).

(2) Because it misinterpreted *Smith* v. *Goodyear Dental Vulcanite Co.*, 93 U.S. 484–486, decided in 1876.

In *Hotchkiss* v. *Greenwood, supra,* this Court decided that the substitution of one well known material for another as an element of an old combination does not "of itself" constitute patentable invention, even though it is "better and cheaper" and "better adapted to the purpose". In *Smith* v. *Goodyear, supra,* this Court ruled that invention was present where, *in addition* to the substitution of materials, there was a "new contrivance" and a new process. In the case at bar the Court of Appeals for the First Circuit overlooked the distinction between these cases. It failed to perceive that in substituting a compounded wax for an uncompounded wax there was not, in addition, any new function, new co-operation or contrivance and no new process; and therefore, that the case did not fall within the decision in *Smith* v. *Goodyear,* and conflicts with the rule of *Hotchkiss* v. *Greenwood.*

Also, **there is a conflict of opinion** between the First and Second Circuits on the one hand and the Third and Seventh Circuits on the other hand as to what rule of law governs patentable invention where one old material has been substituted for another.

The First and Second Circuits interpret the decisions of this Court to mean that the substitution of one material for another *of itself* may be an inventive act.

United Shoe Machinery Corp. v. *E. H. Ferree Co.,**
64 F. (2d) 101 (C.C.A. 2).
Grant v. *Russell,* 154 F. (2d) 729 (C.C.A. 1).

The Third and Seventh Circuits interpret the decisions of this Court to mean that, *of itself,* the substitution of one

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* In this case a petition for certiorari was *granted* by this Court at the Oct. Term 1933, No. 1257, 290 U.S. 614. It raised precisely the question raised by the case at bar, but the case was dismissed by agreement of counsel and never argued or decided.

material for another is not an inventive act, but that something more than substitution, for instance, "a new process or contrivance", co-operation or relationship is required.

See *Fowler* v. *Honorbilt Products*, 131 F. (2d) 153 (C.C.A. 3).

Lafferty Mfg. Co. v. *Acme Ry. Signals & Mfg. Co.*, 138 F. 729, 730 (C.C.A. 7).

Angier v. *Nehring Elec. Works*, 45 F. (2d) 354, (C.C.A. 7).

This Court has never resolved the conflict of law arising from varying interpretations of its decision in *Smith* v. *Goodyear* and of its dicta in that and subsequent cases. During the seventy years since the decision in *Smith* v. *Goodyear*, the whole aspect of industry has changed. The progress of the arts will be seriously impeded and the purpose of the constitutional provision for the grant of patents defeated if a valid patent may be obtained each time a useful substitution of one material for another is made.

The decision of the Circuit Court of Appeals for the First Circuit also misinterpreted and is in conflict with the decision of this Court in *Sinclair* v. *Carroll Co. Inc.* v. *Interchemical Corp.*, 325 U.S. 327.

The preservation and distribution of foods and other products in the present emergency should not be handicapped for any period of time however short by a patent monopoly, unless the patent on which that monopoly rests is clearly a rightful one under the patent statutes and the decisions of this Court.

JURISDICTION.

(1) This is a suit arising under the Patent Laws of the United States, Judicial Code, Sec. 24 (7), (28 U.S.C. Sec. 41 (7)).

(2) The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925 (28 U.S.C. Sec. 347).

(3) The date of the judgment which petitioner seeks to have reviewed is April 17, 1946.

(4) Cases believed to sustain the jurisdiction are:

Fruit Growers Inc. v. *Brogdex Co.*, 283 U.S. 1; *DeForest Radio Co.* v. *Gen. Elec. Co.*, 283 U.S. 664; *Schriber Co.* v. *Cleveland Trust Co.*, 311 U.S. 211; *Carbice Corp.* v. *Am. Patents Corp.*, 282 U.S. 27.

QUESTIONS RAISED BY THE CASE.

1. Does the substitution of one material for another in an old combination constitute a patentable invention, when no new contrivance, method or relationship is involved, and, where an improved result is attributable only to the well known properties inherent in the material?

2. Can substitution of materials by itself constitute invention if there is an increase in efficiency and a saving in operation, but no new contrivance, method or relationship?

3. Did it constitute patentable invention to substitute amorphous petroleum wax containing a colloid for paraffin (Beecher) or oxidized petroleum residuum (Fietsch) or paraffin and rubber (Johnson) as the adhesive by which the two paper layers of a laminated paper container are stuck together, the properties of amorphous petroleum wax with respect to adhesiveness, flexibility and moisture-vapor proofness being well known?

4. Did the Circuit Court of Appeals, in adjudging claim 3 to be valid and in appraising the rights of the public misinterpret and misapply the principles governing inven-

tion and the respective rights of the patentees and the public, enunciated by this Court in *Hotchkiss* v. *Greenwood, supra, Smith* v. *Goodyear Dental Vulcanite Co., supra,* and *Sinclair-Carroll Co.* v. *Interchemical Corp., supra?*

REASONS RELIED ON FOR THE ALLOWANCE OF THE WRIT.

1. Because the conflict of decision between the First Circuit on the one hand and this Court and other circuits on the other hand should be resolved before even greater confusion results and to the end that there may be uniformity of decision.

2. The decision of the Circuit Court of Appeals for the First Circuit will put in the hands of the respondent a monopoly of moisture-proof paper boxes and wrappings laminated with amorphous petroleum wax,—a monopoly which is far broader than is justified by a mere improvement in the adhesive.

3. The public interest in the right to use commercially available amorphous petroleum wax carrying a natural suspended colloid for the preservation of food demands freedom from any monopoly not clearly sanctioned by the applicable decisions of this Court.

4. Because the public interest requires that freedom to substitute one material for another and to use whatever material is best suited for the purpose be not abridged and the patent law be not used "as a dam to divert natural changes and evolutionary progress in the arts into the laterals of monopoly."*

5. Because the decision of the Circuit Court of Appeals for the First Circuit is probably in conflict with the applicable decision of this Court in *Sinclair & Carroll* v. *Interchemical Corp., supra.*

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* *Evr-Klean Seat Pad Co.* v. *Firestone Tire & Rubber Co.,* 118 F. (2d) 600.

PRAYER:

Wherefore your petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this Honorable Court directed to the Circuit Court of Appeals for the First Circuit commanding that Court to certify and to send to this Court for its reviewing and determination, on a day certain to be therein named, a full and complete transcript of the record and all proceedings in the case numbered and entitled on its docket No. 4044 *Grant Paper Box Company, Plaintiff-Appellant* v. *Russell Box Company, Defendant-Appellee,* that the said decree of the Circuit Court of Appeals for the First Circuit may be reviewed by this Honorable Court, and that your petitioner may have such other and further relief in the premises as to this Honorable Court may seem meet and just.

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BRIEF IN SUPPORT OF MOTION.

OPINIONS OF THE COURTS BELOW.

The opinion of the District Court (Findings of Fact, Conclusions of Law and Memorandum Modifying) is reported in 61 U.S.P.Q. 209. See also R. 14–18.

The original opinion of the Court of Appeals is reported in 151 F. (2d) 886, R. 465 and the opinion on Rehearing reversing its original judgment is reported at 154 F. (2d) 729, R. 487–490.

STATEMENT.

The facts are believed to be sufficiently stated in the petition.

SPECIFICATION OF ERRORS.

If the Writ of Certiorari is allowed Petitioner will urge that the Circuit Court of Appeals for the First Circuit erred:

(1) In holding that a substitution of materials in and of itself amounted to patentable invention.

(2) In not adjudging claim 3 of the patent to Dreymann No. 2,031,036, invalid in view of *Hotchkiss* v. *Greenwood, supra,* and *Sinclair & Carroll Inc.* v. *Interchemical Corp., supra.*

(3) In not adjudging claim 3 of the patent in suit invalid because of the prior patents and publications contained in the record and particularly the patents to Johnson No. 229,045; Beecher No. 1,936,375; Fietsch No. 1,269,918; Hoch No. 1,780,917; MacLaren No. 1,905,923; Rose No. 2,036,301; Pearsall No. 1,968,907, and the article entitled "The Petroleum Waxes" by Buchler & Graves, R. 395.

(4) In not adjudging claim 3 of the patent in suit invalid because the alleged invention of claim 3 amounts only to the substitution of an old and well-known wax for paraffin and wax mixtures as the adhesive layer of a laminated paper sheet used for a container wall.

(5) In not adjudging that, in view of limitations in the

specification and estoppel by cancellation of claims, claim 3 is limited to the addition of a foreign colloid to amorphous petroleum wax, and in adjudging that said claim 3 is infringed by a container wall having an intermediate layer composed of a blend of two waxes containing only their inherent natural colloids.

ARGUMENT.

Point I.

THE DECISION OF THE CIRCUIT COURT OF APPEALS FOR THE FIRST CIRCUIT IN THE CASE AT BAR IS IN CONFLICT WITH THE DECISION OF THIS COURT IN HOTCHKISS v. GREENWOOD THAT SUBSTITUTION OF MATERIALS OF ITSELF DOES NOT CONSTITUTE INVENTION. THE CASE AT BAR SQUARELY RAISES THE QUESTION.

1. Dreymann's Alleged Invention Was Only the Substitution of One Wax for Another in an Old Combination.

Claim 3 is essentially for a container wall made of two plies of paper stuck together with wax carrying a suspended colloid. Wax had been used to stick together "two sheets of fibrous material" (Johnson, R. 438; Beecher, R. 449; and Fietsch, R. 456); a laminated sheet containing a wax adhesive had been made into a container (Fietsch, R. 456); amorphous petroleum wax was known and it had been recognized that it contained a colloidal material (Buchler & Graves, R. 395); its adhesive and moisture-proofing properties were known (MacLaren, R. 445 and Pearsall, R. 382); amorphous petroleum wax was known to be tough and flexible (Pearsall, R. 451). Ordinary amorphous wax was known to have a wide range of melting points. Colloids had been added to wax (rubber by Johnson and Rose; rosin by MacLaren, and ester gum by Pearsall).

No novelty resided in the combination of wax and paper to form a laminated, flexible, moisture-vapor proof wall,

nor in substituting a compounded wax for an uncompounded one as the adhesive with which to stick together two sheets of paper to make such a wall. The container wall defined in the claim differed from the old container walls if at all only in degree of moisture proofness and flexibility. There was no novelty outside of the substitution—no new function, method or contrivance. The elements of the combination had no new interrelation or cooperation. The container was better simply because the wax used was better. Consequently, the question is squarely presented as to whether the substitution of material, without more, constitutes invention.

2. What This Court Has Decided as to Substitution of Materials.

In *Hotchkiss* v. *Greenwood,* 11 How. 248, the alleged invention was the substitution of a porcelain door-knob for one of wood or metal. This Court said:

> ". . . the novelty consisted in the substitution of the clay knob in the place of one made of metal or wood, as the case might be." (p. 265)
>
> . . . . . .
>
> The improvement consists in the superiority of the material, and which is not new, over that previously employed in making the knob. But this, *of itself,** can never be made the subject of a patent."

This decision, therefore, lays down the general rule that, where the novelty consists in substitution of material, this *"of itself"* is not invention.

This decision was followed in 1876 by *Smith* v. *Goodyear Dental Vulcanite Co.,* 93 U.S. 486. In this case the patentee (Dr. Cummings) substituted rubber for metal in the plates of artificial teeth and vulcanized the rubber so that it held

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* Italics ours throughout.

the individual teeth tightly and sealed the joints about them. There was both a new process and a new cooperation or interaction of the materials. The Court said that the new process was "as much a part of the invention as are the materials of which the product is composed" (p. 493). Accordingly, the Court held that "what Cummings accomplished was more than a substitution of one material for another—that it was in truth invention" (p. 495). Therefore, the *Smith* case like the *Hotchkiss* case holds that *something more* than the substitution of one material for another is necessary if the patent is to be sustained. Each case decides that substitution of materials *per se* is not invention, and that novelty must be found in something outside of and beyond the substitution. In the *Hotchkiss* case, the something was wanting; in the *Smith* case, it was the new process, the new contrivance, the new relationship.

No case decided by this Court holds that substitution of materials "of itself", however beneficial, amounts to invention. Either the patents have been held invalid[1] or invention has been found in something outside of and beyond the substitution.[2]

3. The Confusing Dicta of This Court.

In a case, *Hicks* v. *Kelsey*, 18 Wall. 670, previous to the cases under discussion this Court had said:

> "The use of one material instead of another in constructing a known machine is, in most cases, so obvi-

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[1] *Hicks* v. *Kelsey*, 18 Wall. 670, 673.
Collar Co. v. *Van Dusen*, 90 U.S. (23 Wall.) 530, 563.
Terhune v. *Phillips*, 99 U.S. 592.
Slawson v. *R.R. Co.*, 107 U.S. 649, 653.
Gardner v. *Herz*, 118 U.S. 180, 192.
Brown v. *District of Columbia*, 130 U.S. 87, 99.
Florsheim v. *Schilling*, 137 U.S. 64.

[2] *Potts* v. *Creager*, 155 U.S. 597.
Magowan v. *New York*, 141 U.S. 332.

> ously a matter of mere mechanical judgment, and not of invention, that it cannot be called an invention, unless some new and useful result, an increase of efficiency, or a decided saving in the operation, is clearly attained." (p. 673)

In *Smith* v. *Goodyear,* this Court quoted this dictum and since that time other courts have taken it as stating an exception to the rule of the *Hotchkiss* case, *viz.*—that substitution may constitute invention if it is not obviously a matter of mere mechanical skill, and provides some new and useful result, some increase of efficiency or some saving. But this Court has never so decided and has never receded from its position in *Hotchkiss* v. *Greenwood.* Contrary to general belief it has not established an exception to the rule of that case.

The remark in *Smith* v. *Goodyear* that the product was a thing different in kind rather than in degree has also been taken out of its context to mean something which we believe was not intended by this Court. In the *Smith* case, the product was different in kind because it was a "new contrivance", because of the novel cooperation and interrelationship of its elements resulting from the novel process by which it was made. But the Court of Appeals fell into error and used the expression "different in kind" to describe something that is different only because the substitution of a material makes it so.

We submit that this Court should make clear the distinction between its decisions in *Hotchkiss* v. *Greenwood* and *Smith* v. *Goodyear.*

Point II.

THERE IS CONFLICT OF LAW BETWEEN THE FIRST AND SECOND CIRCUITS ON THE ONE HAND AND THE THIRD AND SEVENTH CIRCUITS ON THE OTHER AS TO THE RULE OF LAW RELATING TO SUBSTITUTION OF MATERIALS.

1. The Rule in the Third and Seventh Circuits.

The Third and Seventh Circuits have followed *Hotchkiss* v. *Greenwood* in requiring a showing of novelty over and beyond the substitution of materials. The nature of the conflict is illustrated by the recent decision of the Third Circuit Court of Appeals in *Fowler* v. *Honorbilt Products,* 131 F. (2d) 153 in which the court held that it did not amount to invention to substitute combed sisal for cotton for padding in upholstery. After discussing the rule of *Hotchkiss* v. *Greenwood* and the corollary of *Smith* v. *Goodyear* the Court said:

> "The pad of the patent in suit is constructed in exactly the same way that pads of fibers other than sisal had been made for many years. The better article derived from the use of sisal was not the result of any *new contrivance or process* described by the patent. It was due alone to the fact that the peculiar properties and characteristics of sisal rendered it superior for padding purposes in upholstery—a fact which had long been widely known and understood. The mere adaptation of sisal to the particular manufacture could not, therefore, be the subject of a patent." (pp. 156–7)

In *Lafferty Mfg. Co. et al.* v. *Acme Ry. Signal & Mfg. Co.,* 138 F. 739–40, 1905, the Seventh Circuit held that the substitution of paper for tin or lead for the cap of a railroad torpedo was not invention although the existing torpedoes had been superseded.

In *Angier et al.* v. *Nehring Electrical Works,* 45 F. (2d) 354, 1930, the Seventh Circuit also held that it did not constitute invention to use crepe paper instead of flat paper or burlap for wrapping tires, notwithstanding the fact that crepe paper had important advantages and, as was alleged in the bill of complaint and therefore was assumed on motion to dismiss, had replaced flat paper and burlap almost completely. In that case the Court said:

> "Surely the quality of invention does not reside in the employment of an old element in a connection where it exhibits only those uses, functions and qualities which were long theretofore recognized and understood." (p. 355)

In summary, in the Third and Seventh Circuits, as in this Court, a case of "mere" substitution is one in which the only novelty lies in the material, and invention is held lacking in the absence of some new contrivance, relationship of elements, or new process.

2. The Rule in the First and Second Circuits.

The First and Second Circuits, following the dicta of this Court in *Hicks* v. *Kelsey, supra,* and *Smith* v. *Goodyear, supra,* but not the decisions, hold that there is invention when the novelty resides solely in the substitution, without any new contrivance, process or cooperation of elements, if the improvement is an important one commercially, resulting in savings or improved results.

In *United Shoe Machinery Corp.* v. *E. H. Ferree Co.,** 64 F. (2d) 101, the sole novelty consisted in the substitution of aluminum alloy for iron in the arm of a machine for cut-

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* In this case a petition for certiorari was *granted* but the case was never argued or decided. See footnote on page 4, *supra.*

ting out parts of shoes with the result that the operation of the machine was less fatiguing to the workman. The Court held that this amounted to invention and said:

> "But it is said that this was a mere substitution of material and therefore does not rise to the dignity of invention . . . The use of one known material instead of another in constructing a known machine is in most cases so obvious as a matter of mere mechanical judgment as not to be inventive thought, *but* it can amount to invention if some new and useful result or increase in efficiency and decided saving in the operation is clearly obtained." (p. 103)

In *Smokador Mfg. Co.* v. *Tubular Products Co.*, 31 F. (2d) 255, C.C.A. 2, the sole novelty consisted in the substitution of glass for metal in the bottom of a large cigar ash stand, so that the attendant would know when to empty it. The Second Circuit held that this was an invention, on the ground that the apprehension of the advantages "involved more than the work of the routine mind".

And in *Grant* v. *Russell,* 154 F. (2d) 729, the case at bar, the First Circuit on rehearing has adopted the same line of reasoning as the Second Circuit in *United Shoe* v. *Ferree, supra,* and held that the substitution of a colloid-bearing amorphous petroleum wax for paraffin wax as a bonding agent for paperboard was an invention. After acknowledging that the patentee's wax was "a commercially available compound having known characteristics" (R. 488), the Court held that *Hotchkiss* v. *Greenwood* did not control notwithstanding the fact that the only novelty was the substitution of one wax for another, and said that the case was governed by *Smith* v. *Goodyear.* It thought Dreymann's alleged invention was for a product different in kind rather than in degree because it had greater moisture-proofness and flexibility. The Court failed to realize that in *Smith* v. *Goodyear* this Court found a "difference in kind" only

where the product had a new cooperation of elements and was made by a new process.

The Court below also said that Dr. Cummings in the *Goodyear* case had "done more than simply to use hard rubber", and that likewise Dreymann had done more than simply to substitute one known material for another. But the "something more" in Dreymann's case was in the words of the Court of Appeals[1] "to produce a thin flexible moisture-vapor-proof box board which could be written or printed upon and which could be folded to make small boxes or cartons without losing its highly desirable moisture-vapor-proof characteristic". This describes a container wall in words practically paraphrasing Fietsch—one better in degree than either Beecher's[2] or Fietsch's[3] but not a new contrivance, nor a container wall made by a new method.

The Court of Appeals went wrong in its reasoning because it did not realize that in the *Goodyear* case the "something more" resulted from the new contrivance and process. The Court did not appreciate that a product is not different in kind under the rule of *Smith* v. *Goodyear* unless some new contrivance or process provides an improved result not limited to the superiority of the substituted material itself.

In each of the last three cases[4] the patentee merely applied the inherent and well recognized qualities of an element to a particular use, yet the First and Second Circuits found the improvement to constitute a patentable invention, thus going squarely contrary to the Third and Seventh Circuits and far beyond anything which this Court has held to constitute invention.

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[1] Court of Appeals Opinion, R. p. 489.

[2] Beecher patent No. 1,936,375, R. 448.

[3] Fietsch patent No. 1,269,918, R. 456.

[4] *United Shoe* v. *Ferree; Smokador* v. *Tubular;* and *Grant* v. *Russell.*

Therefore, we submit, that the Third and Seventh Circuits are squarely in conflict with the First and Second Circuits.

We find no basis in the facts for reconciling these conflicting decisions. The substitution of sisal for cotton[1]; paper for tin[2]; crepe paper for flat paper[3]; aluminum for iron or steel[4]; glass for metal[5] and colloid-carrying amorphous wax for paraffin wax[6] cannot be considered as presenting different states of fact. In every case the facts were essentially the same but the result was "new" only to the extent that the new material made it so. The conflicting Courts of Appeals were obviously guided by totally different legal standards of what constitutes invention when one well known material is substituted for another. They differed as to whether "of itself" a substitution of material might be invention. The misunderstandings as to the principle to be applied and the consequent conflict will continue until this Court clarifies the situation.

Thus there is complete confusion among the circuits. While paying lip service to the rule of *Hotchkiss* v. *Greenwood*, some courts use the dictum of *Smith* v. *Goodyear* to justify holding that substitution of materials of itself amounts to an invention. When cases involving substitution of materials arise, they are often treated as if only questions of fact were raised and no search is made for the true rule of law to be applied. Thus the confusion continues and will continue until corrected by this Court.

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[1] *Fowler* v. *Honorbilt*.

[2] *Lafferty* v. *Acme*.

[3] *Angier* v. *Nehring*.

[4] *United Shoe* v. *Ferree*.

[5] *Smokador* v. *Tubular*.

[6] *Grant* v. *Russell*.

Point III.

THE LAW AS TO THE SUBSTITUTION OF MATERIALS HAS NOT KEPT PACE WITH DECISIONS OF THIS COURT ON WHAT CONSTITUTES PATENTABLE INVENTION.

Within the last ten years this Court has recognized that the rising level of mechanical and scientific skill demands a progressively higher standard of invention.[1] In line with this growth of the law, this Court has also condemned the extension of a monopoly on an old combination resulting from the improvement of one of its elements.[2] In the *Bassick* case, Gullborg substituted a new connector or fitting in an old lubricating system; in the case at bar Dreymann substituted a different wax as the adhesive in Fietsch's old laminated container wall. The Court should rule that substituting one known material for another in an otherwise old combination stands on the same footing as substituting an improved element and is open to the same fundamental condemnation. The law on substitution of materials has not progressed—rather it has retrograded, and it remains for this Court to bring the law up to the same high standard which it requires in other cases where patentability is in question.

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[1] *Cuno Engineering Corp.* v. *The Automatic Devices Corp.*, 314 U.S. 84.

[2] *Bassick* v. *Hollingshead*, 298 U.S. 415; see also *Lincoln Engineering Co.* v. *Stewart Warner*, 303 U.S. 545 for an identical situation.

Point IV.

AN IMPORTANT QUESTION OF PUBLIC POLICY IS INVOLVED, NAMELY—THE RIGHT OF THE PUBLIC TO PROFIT BY THE DEVELOPMENT OF NEW MATERIALS AND NOT BE HAMPERED BY PATENTS ON THE MERE SUBSTITUTION OF ONE MATERIAL FOR ANOTHER.

During the seventy years which have elapsed since this Court has made an authoritative statement on "substitution of materials", the question has assumed great public importance because of the quickened pace of scientific and industrial development. During this time more than twenty-five new elements of matter have been discovered and thousands of new compositions have been originated. Hundreds of new metal alloys have been discovered. Practically all, if not the entire, development of synthetic condensation products such as Bakelite, viscose and synthetic rubber has taken place. Innumerable products derived from the distillation and synthesis of petroleum have been put on the market. Each new material has given the public a new tool to work with and has been followed by an ever widening list of uses.

Freedom in the choice of materials is essential to industrial development. The wise rule laid down by this Court in *Hotchkiss* v. *Greenwood, supra,* that making a machine "of materials better adapted to the purpose for which it is used than the materials of which the old one is constructed" cannot "entitle the manufacturer to a patent" has contributed materially to industrial development. To grant a patent each time a new material supplants an old one for a particular use will retard and not "promote the progress of science and useful arts".

We respectfully submit that this Court should reaffirm its wise rule against repatenting old combinations by substitutions of material and put an end to the insidious relaxation which the decisions of the First and Second Circuits are bringing about.

The value of our patent system depends on a nice adjustment between public and private rights. While it is for the public interest that inventors should be confirmed in "the exclusive right" "for limited times" to "their respective discoveries", it is equally important that patentees should not be allowed to trench upon the public domain by claiming as inventions improvements which are the result of judicious selection of the material to be used and, hence, should be the property of the public.

Point V.

THE PUBLIC IMPORTANCE OF PRESERVING THE PRESENT LIMITED FOOD SUPPLIES DEMANDS AN IMMEDIATE REVIEW OF THE MONOPOLY IN QUESTION.

The effect of the decision of the first Circuit is to keep the public from using a particular natural wax as the adhesive for the walls of laminated containers. The present shortage of foods will be further aggravated if they cannot be packed in containers made with every commercially available form of wax.[1] The public should be free to use whatever is best to keep foodstuffs from deterioration. We submit that these are cogent reasons for granting the writ.

Exceptional circumstances affecting the public have been deemed sufficient to warrant granting the writ of certiorari, even in the absence of conflicting decisions as to the validity of the patent involved.[2] Such exceptional circumstances are not restricted to those arising from facts of any particular character. The power of the Court is "coextensive with all

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[1] It is expected that during the year 1946, 42,400,000 lbs. of amorphous petroleum wax will be used in lamination by the paper industry. (Affidavit of John C. Dean, printed in appendix.)

[2] *DeForest Radio Co.* v. *Gen. Elec. Co.*, 283 U.S. 664;
Schriber Co. v. *Cleveland Trust Co.*, 311 U.S. 211;
Leitch Mfg. Co. v. *Barber Co.*, 302 U.S. 458, 461;
United Carbon Co. et al. v. *Binney & Smith Co.* U.S. ;
Sinclair & Carroll v. *Interchemical Corp.*, 325 U.S. 327.

possible necessities". *Forsyth* v. *Hammond*, 166 U.S. 503, 514.

CONCLUSION.

We respectfully submit that the public interest requires that the question of invention by substitution of materials should be again considered and that the standard of invention with respect to this matter, which has been lowered by the decisions of the First and Second Circuits, be restored to its previous level by a decision of this Court which will speak in unmistakable terms.

Respectfully submitted,

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GEORGE P. DIKE,
GEORGE P. TOWLE, JR.,
RODERICK W. HOAG,
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350 Tremont Building, Boston, Mass.

July, 1946.

IN THE SUPREME COURT OF THE UNITED STATES.

GRANT PAPER BOX COMPANY,
Respondent (Plaintiff),
v.
RUSSELL PAPER BOX COMPANY,
Petitioner (Defendant).

AFFIDAVIT OF JOHN C. DEAN.

STATE OF NEW YORK,
COUNTY OF NEW YORK, ss.

JOHN C. DEAN, being duly sworn, deposes and says:

I am 36 years of age, a resident of Douglaston, New York and am employed by Socony-Vacuum Oil Company, Inc., 26 Broadway, New York 4, New York, as Manager of Process Products Division of Lubricating Department, in connection with the sale of "process products" meaning, generally, oil products used in the manufacturing and/or processing of other industries and among other products, specifically having to do with "micro-crystalline wax" or "amorphous" or "petrolatum waxes", these being various names applied to waxy products of petroleum refining derived from crude oil and having a small or micro-crystalline form, melting points ranging from 140°F. to 175°F. and viscosities (seconds, Saybolt-Universal) of about 70 seconds at 210°F.

Under instructions from my superiors, and immediately after the cessation of hostilities in 1945, I made a survey of post-war micro-crystalline wax requirements to ascertain the total amount of micro-crystalline waxes likely to be required in this country in the immediate future and as a guide for my company in its manufacturing and sales operations. In the course of making this survey, I had representatives of the company interview customers and non-customers who were present and prospective users of wax over the entire country. On the basis of their reports, I made the following estimates.

Total amount of micro-crystalline wax likely to be used for all purposes in the year 1946....89,400,000 lbs.

Amount likely to be used in lamination by the paper industry in 1946.....42,400,000 lbs.

I am aware that this estimate, due to the way in which data were collected, probably contains some duplication which cannot be ascertained.

In my opinion, the figures given above, even with suspected inaccuracy are not materially too high.

Business arrangements of my company with respect to micro-crystalline waxes will be based upon the above estimate.

JOHN C. DEAN.

Sworn to and subscribed before me this fifth day of June, 1946.

EDITH LAFFERTY,
Notary Public. [SEAL]

Edith Lafferty
Notary Public Kings County
Kings Co. Clk's No. 574, Reg. No. 447-L-7
N.Y. Co. Clk's No. 639, Reg. No. 644-L-7
Commission Expires March 30, 1947